

REMARKS

I. Introduction

The Current Action:

Rejects claims 16–18 and 20–22 as unpatentable under 35 U.S.C. § 102(e); and

Rejects claims 23–50 as unpatentable under 35 U.S.C. § 103(a).

The Present Response:

Amends claims 23, 33, and 42;

Cancels claims 16–18, 20–22, 25, 38–41, and 43;

Adds claims 51 and 52; and

Traverses the remaining rejections.

Claim 23 has been amended to include the limitations of claim 25 and claim 42 has been amended to include the limitations of claim 43. Claims 26 and 44 have been amended to depend from claims 23 and 42 respectively. Claims 23 and 33 have been amended to more clearly describe the claimed invention, and support for these amendments can be found, among other places, at page 10 lines 10-14 as well as page 11 line 25 – page 12 line 6. No new matter has been added. Claims 16–18, 20–22, 25, 38-41, and 43 have been canceled, and the Current Action’s rejections of those claims are now moot. Claims 23, 24, 26–34, 36, 37, 42, and 44–50 remain pending in the current application, and the Applicants respectfully ask the Examiner to withdraw the remaining rejections in light of the arguments contained herein.

II. Arguments

A. The Rejections Under § 102(e)

In the Current Action, claims 16–18 and 20–22 are rejected as anticipated by Lastinger, U. S. Patent No. 6,104,311 (hereinafter *Lastinger*). This Response cancels claims 16–18 and 20–22, rendering these rejections moot.

B. The Rejections Under § 103(a)

Each pending claim in the present application has been rejected under 35 U.S.C. § 103(a) as obvious in light of one of several reference combinations. The Applicants respectfully remind the Examiner that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, the Examiner's proposed combination of references must teach or suggest each and every limitation of the claim rejected using that combination. Second, there must be some suggestion or motivation to combine reference teachings found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Third, the combination must have inspired a reasonable expectation of success. *See* M.P.E.P. § 2143. Without conceding that the second and third criteria have been met, the Applicants respectfully submit that the Examiner's proposed combinations do not teach or suggest all of the limitations of the rejected claims.

Claim 23 stands rejected as obvious in light of a combination of *Bowers*, U.S. Patent No. 5,963,134 (hereinafter *Bowers*) and Francis et al., U.S. Patent No. 6,600,418 (hereinafter *Francis*). However, claim 23 recites a "container comprising . . . object presence detection equipment internal to said container . . . [and] wherein said set of objects is disposed in a configuration selected from a linear array, a two-dimensional array, and a three-dimensional array." The Applicants respectfully assert that the Examiner's proposed combination fails to teach such a container. FIGURE 9 of *Bowers* does not teach this container, as contended by the Current Action in the rejection of claim 25. Rather, as described at column 15 lines 43–58, FIGURE 9 illustrates a shelf of articles scanned by a portable scanner that is external to the depicted shelf. In addition, claim 23 recites "at least one transmitter of transmitted signal energy and a plurality of fixed receivers." *Bowers* does not teach such an arrangement either. Nor can these deficiencies of *Bowers* be cured by combining *Bowers* with *Francis*, because *Francis* does not teach or suggest a container as recited by claim 1 either. Because neither *Bowers* nor *Francis* teach or suggest a "container comprising . . . object presence detection equipment internal to said container . . . [and] wherein said set of objects is disposed in a configuration selected from a linear array, a two-dimensional array, and a three-dimensional array" and does not teach or suggest "at least one transmitter of transmitted signal energy and a plurality of fixed receivers," the combination of *Bowers* and *Francis* does not establish a

prima facie case of obviousness for claim 23. Therefore, the Applicants respectfully ask the Examiner to withdraw the rejection of claim 23.

Claims 24 and 26–32 depend either directly or indirectly from claim 23 and thus inherit all of that claim’s limitations. While each of claims 24 and 26–32 recite limitations which make them patentable in their own right, the Applicants respectfully submit that each is at least patentable for depending from claim 23. Therefore, the Applicants respectfully ask the Examiner to withdraw the rejections of claims 24 and 26–32.

Claim 33 is also rejected as obvious in light of a combination of *Bowers* and *Francis*. Claim 33, however, includes identifying a subset of objects within a container by “transmitting a selected frequency signal within said container . . . modifying said transmitted signal at said selected frequency by at least one object of said set of objects, wherein said at least one object is a member of said subset, and wherein said subset comprises a plurality of said objects responsive to said selective frequency.” The Applicants respectfully assert, however *Bowers* does not teach or suggest identifying subsets in this manner. Further, *Francis* does not teach or suggest identifying subsets as recited in claim 33 either. Thus the combination of *Bowers* and *Francis* can not establish a prima facie case of obviousness for claim 33, and the Applicants respectfully ask the Examiner to withdraw the rejection.

Claims 34, 36, and 37 depend either directly or indirectly from claim 33. Although each of claims 34, 36, and 37 recite limitations that make these claims patentable in their own right, each is at least patentable for depending from patentable claim 33. Therefore, the Applicants respectfully ask the Examiner to withdraw the rejections of claims 34, 36, and 37.

Claim 42 is also rejected as obvious in light of *Bowers* and *Francis*. However claim 42 recites “a tape storage container comprising . . . object presence detection equipment internal to said container . . . [and] a plurality of tape cartridges . . . wherein said plurality of tape cartridges is disposed in a configuration selected from a linear array, a two-dimensional array, and a three-dimensional array,” and the combination of *Bowers* and *Francis* does not teach such a container. FIGURE 9 of *Bowers* does not teach these limitations, as the Current Action contends in its rejection of now canceled claim 43, because *Bowers* places its transmitters outside of the container housing the array of articles. Further, *Francis* does not

to teach or suggest a container as recited in claim 42 either. Thus the combination of *Bowers* and *Francis* can not establish a prima facie case of obviousness for claim 42, and the Applicants respectfully ask the Examiner to withdraw the rejection.

Claims 44–50 depend either directly or indirectly from claim 42. Although each of claims 44–50 recite limitations that make them patentable in their own right, each is at least patentable for depending from patentable claim 42. Therefore, the Applicants respectfully ask the Examiner to withdraw the rejections of claims 44–50.

Claims 30 and 48 have been rejected over a combination of *Bowers*, *Francis*, and in further light *Lastinger*. However, claim 30 depends from claim 23 and inherits all the limitations of claim 23, and claim 48 depends from claim 42 and inherits all the limitations of claim 42. As demonstrated above, the combination of *Bowers* and *Francis* does not teach all of the limitations of claim 23, and does not teach all of the limitations of claim 48. *Lastinger* does not teach or suggest the missing limitations of claims 23 and 43 either. Therefore, the combination of *Bowers*, *Francis*, and *Lastinger* fails to teach or suggest all of the limitations of claims 30 and 48, and thus fails to establish a *prima facie* case for rejecting either claim. The Applicants respectfully ask the Examiner to withdraw the rejections of claim 30 and claim 48 as well.

Claims 31 and 49 have been rejected over a combination of *Bowers*, *Francis*, and in further light of *Greene*, et al., U.S. Patent No. 5,581,257 (hereinafter *Greene*). However, claim 31 depends from claim 23 and claim 49 depends from claim 42, thus each inherits all of the limitation of its respective base claim. As demonstrated above, the combination of *Bowers* and *Francis* does not teach or suggest all of the limitations of claim 23, and does not teach or suggest all of the limitations of claim 42. Further, *Greene* does not teach or suggest the limitations of claims 30 and 42 missing from the combination of *Bowers* and *Francis* either. Therefore, the combination of *Bowers*, *Francis*, and *Greene* fails to teach or suggest all of the limitations of either claim 31 or 49, and thus fails to establish a *prima facie* case for rejecting either claim. The Applicants respectfully ask the Examiner to also withdraw the rejections of claims 31 and 49.

III. New Claims 51 and 52

New claims 51 and 52 depend directly from patentable claim 33. The Applicants respectfully assert that each recite limitations not taught nor suggested by the prior art of record, and respectfully request that they be allowed.

IV. Conclusion

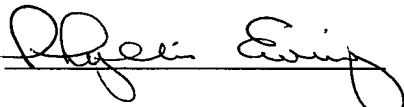
In view of the above, each of the presently pending claims 16, 17, 18, and 20-50 in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10004955-1 from which the undersigned is authorized to draw.

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Date of Deposit: August 9, 2004

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